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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,660	02/15/2001	M. Salahuddin Khan	N0084 US	2233

7590

03/24/2004

Navigation Technologies Corporation
Attention Patent Department
222 Merchandise Mart Plaza
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Chicago, IL 60654

EXAMINER

NOLAN, DANIEL A

ART UNIT

PAPER NUMBER

2654

15

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/784,660

Applicant(s)

KHAN ET AL.

Examiner

Daniel A. Nolan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-18, 20 and 21 is/are allowed.
- 6) ☒ Claim(s) 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 14 July 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Arguments

2. Applicant's arguments filed 12 March 2004 have been fully considered but they are not persuasive.

The features of the claims were read against by the prior art of reference, the issue being that the prior art maintains data representations as separate parts, where the instant application would organize them by location. The rejection is maintained as having been obvious to a person of ordinary skill in the art of speech signal processing, with particular regard to optimal usage of resources that would combine different data representations into memory to exploit the availability of large amounts of inexpensive memory to avoid mechanical delay, using the long-accepted technique of partitioning memory into logical files in memory rather than physical files in storage.

As the claim is not specifically limiting as to the mechanics of storage and retrieval but is, instead, directed at the organization of the data, it is immaterial whether the parts included in the claimed word list exist in logical or physical arrangements. Examination of the instant claim 19 of the application found that the two parts do exist

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separately in prior art and that combining them into logical parts is not only obvious but would have been expected of an artisan with the resources at hand.

In response to applicant's argument that the reason or premise for combining Wakisaka et al and Ashby⁴¹⁹ is incorrect, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

With further regard to the issue of the motivation cited in the prior art of reference, "A court or examiner may find the motivation to combine references in the nature of the problem to be solved." See *Ruiz v. A.B. Chance Co.* 69 USPQ2D 1686, No. 03-1333, January 2004.

Claim Rejections - 35 USC § 103

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wakisaka et al (U.S. Patent 6,112,174) in view of Ashby⁴¹⁹ (U.S. Patent 5,974,419).

5. Regarding claim 19, Wakisaka et al (column 2 line 52) reads on the feature of a *positioning system that determines a current location of a vehicle in a region* (col 3 lns 26-27);

- Wakisaka et al (column 54-63) reads on the feature of *an automatic speech recognition system that matches data representations of words spoken by a user of the vehicle to a word list of data representations of spoken names of geographic features*,
- Wakisaka et al (AREA 1-n in figure 3b) reads on the feature that *the word list of data representations of spoken names of geographic features includes only a portion of all available data representations of spoken names of geographic features contained in a geographic database*
... because, each AREA of Wakisaka et al changes nature depending on whether they are in use or not, the remaining dictionaries of Wakisaka et al (as in figure 3B) read on the feature that *the word list of data representations of spoken names of geographic features includes only a portion of all available data representations of spoken names of geographic features*,
- When the vehicle is in the appropriate AREA, Wakisaka et al reads on the feature that *a 1st part that changes to include different words as the vehicle travels in the*

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region such that the 1st part includes words for names of geographic features in proximity to the current location of the vehicle;

The configuration of Wakisaka et al (col 2 lns 23-col 3 ln 45) reads on the feature of a 1st part and a 2nd part (corresponding to the 1st storage unit of claim 13 in col 11 lns 57-62), without explicitly stating that the 2nd part does not change. With the invention for *parcelization of geographic data for storage and use in a navigation application*, Ashby^{'419} describes a system simultaneously representing both *destination* and *present position* (col 5 lns 38-42).

This *destination* information reads on the feature that the word list includes a 2nd part that does not change to include different words as the vehicle travels in the region and that includes words for names of selected geographic features located throughout the region (col 5 lns 30-36) wherein both the 1st and the 2nd part are available to the automatic speech recognition system at the same time (particularly when representing a trip, col 2 lns 42-46).

This would have made it obvious to a person of ordinary skill in the art of speech signal processing at the time of the invention to apply the method/teachings of Ashby^{'419} to the device/method of Wakisaka et al because throughout the course of the trip, *destination* information does not change, while the *present location* does with the progress of the journey.

Allowable Subject Matter

6. Claims 1-18 and 20-21 are allowed.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Daniel A. Nolan at telephone (703) 305-1368 whose normal business hours are Mon, Tue, Thu & Fri, from 7 AM to 5 PM.

If attempts to contact the examiner by telephone are unsuccessful, supervisor Richemond Dorvil can be reached at (703)305-9645.

The fax phone number for Technology Center 2600 is (703)872-9314. Label informal and draft communications as "DRAFT" or "PROPOSED", & designate formal communications as "EXPEDITED PROCEDURE". Formal response to this action may be faxed according to the above instructions,

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or mailed to: Mail Stop AF (or CPA, etc. – see Official Gazette, 04 November 2003)
P.O. Box 1450
Alexandria, VA 22313-1450

or hand-deliver to: Crystal Park 2,
2121 Crystal Drive, Arlington, VA,
Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Technology Center 2600 Customer Service Office at telephone number (703) 306-0377.

Daniel A. Nolan
Examiner
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DAN/d
March 21, 2004


RICHEMOND DORVIL
SUPERVISORY PATENT EXAMINER